

### **REMARKS**

Claims 1-37 are pending in this application. In an Office Action dated May 16, 2007 ("OA"), the Examiner rejected claims 1-37. In this response, Applicants respectfully traverse the rejection and request reconsideration of the rejected claims based on the following remarks.

In addition, Applicants do not automatically agree with or acquiesce to the Examiner's characterization of the claims or the prior art, even if those characterizations are not addressed herein.

#### **Claim Rejections under 35 U.S.C. § 103**

The Examiner rejected claims 1- 37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,892,210 ("Erickson") in view of U.S. Patent No. 6,918,006 ("Archibald") and U.S. Patent No. 6,993,522 ("Chen"). Applicants respectfully traverse the rejection.

Claim 1 recites "comparing at least one data package of the first data object with at least one data package of the copy of the first data object sent by the second system using a consistency check operation stored within the first data object, the second data object, or the copy of the first data object" (emphasis added). Independent claims 13, 25, and 37 provide similar language. To establish a prima facie case of obviousness, the MPEP and the case law requires that (1) the prior art reference must teach or suggest all claimed elements, (2) there must be some reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed, and (3) there must be a reasonable expectation of success. See *MPEP* § 2142 and *USPTO Memorandum* from Margaret A. Focarino, Deputy Commissioner for Patent Operations,

May 3, 2007, page 2. The Examiner has failed to establish at least one of these requirements with regards to claims 1, 13, 25, and 37.

According to the Examiner, Erickson provides “‘comparing at least data package of the first data object with at least one data package of the copy of the first data object sent by the second system’ (See col. 19, lines 55-65 where col. 19, lines 55-65 where the match between fields lists of sync object and the list contained in receive sync profile is determined.)” OA at pages 3-4. Referring to this cited portion and the rest of Erickson, Erickson describes a Sync Object Processor 14 subprogram that resolves any conflict that may have arisen due to a change in the Sync Record. Erickson at col. 10, lines 39-45 [10:39-45]. This Sync Object Processor 14 is part of the Sync Agent 1, which is provided to a plurality of computers who desire to share and manage specific records within a plurality of databases. *Id.* at FIGS. 1A-B and 4:58-65. In other words, the Sync Agent 1, along with the Sync Object Processor 14, are provided to the plurality of computers before any data is transferred. Accordingly, as acknowledged by the Examiner, Erickson fails to disclose, teach, or suggest “comparing at least one data package of the first data object with at least one data package of the copy of the first data object sent by the second system using a consistency check operation stored within the first data object, the second data object, or the copy of the first data object” (emphasis added). OA at page 4.

To overcome Erickson’s deficiency, the Examiner provided Archibald by alleging that “Archibald [] teaches performing data consistency check of parity data inconsistencies during data operations.” OA at page 4. Archibald provides a system for coordinating the execution of one or more data management operations on a data

storage sub-system. Archibald at 1:8-12. These data storage management operations include independent operations operating on user data and/or metadata. *Id.* at 1:15-17. One of these operations can include data consistency checks, stored in memory 107, to be provided on the data storage sub-system. *Id.* at FIG. 2 and 1:17-20. But Archibald only discloses that the data consistency check is stored in a memory 107—not a first data object, the second data object, or the copy of the first data object, as recited in claim 1, 13, 25, and 37. Therefore, like Erickson, Archibald fails to disclose “comparing at least one data package of the first data object with at least one data package of the copy of the first data object sent by the second system using a consistency check operation stored within the first data object, the second data object, or the copy of the first data object” (emphasis added).

Further, the Examiner may attempt to argue that the combination of Erickson and Archibald suggests the “consistency check operation stored within the first data object, the second data object, or the copy of the first data object.” But one of ordinary skill in the art would not expand the scope of Erickson and Archibald because, as provided in the analysis above, Erickson teaches away from this expansion because it clearly discloses that the Sync Object Processor 14, used for resolving any conflicts between data, is stored on the computer before any data is transferred.

Also Chen fails to overcome the deficiencies of Erickson and Archibald. Chen is directed to synchronizing data between mobile devices and fixed devices. Chen provides this synchronization on synchronization server 340. But, like Erickson and Archibald, Chen fails to disclose, teach, or suggest “consistency check operation stored within the first data object, the second data object, or the copy of the first data object.”

Therefore, Erickson in view of Archibald and Chen fails to disclose, teach, or suggest “comparing at least one data package of the first data object with at least one data package of the copy of the first data object sent by the second system using a consistency check operation stored within the first data object, the second data object, or the copy of the first data object” (emphasis added). Accordingly, Applicants respectfully submit that claim 1 is patentable over the cited prior art.

Claims 2-12 depend on claim 1 and are patentable for at least the same reasons as claim 1.

Claims 13, 25, and 37 provide language similar to the language of claim 1. For at least the reasons provided above, Applicants respectfully submit that claims 13, 25, and 37 are patentable over the cited prior art.

Claims 14-24 and 26-36 depend on claims 13 and 25, respectively, and are patentable for at least the same reasons as claims 13 and 25.

### **Final Office Action is Premature**

If the Examiner is not persuaded by the analysis provided above, Applicants respectfully submit that the Final Office Action is premature. MPEP § 706.07(a) states that “[a] second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In this case, the Examiner indicated that the Office Action dated May 16, 2007, is a Final Office Action. Applicants respectfully submit that the Finality of the Office Action

is premature in this case because the Examiner had the opportunity to reject the claimed subject matter over Erickson in view of Archibald in a previous Office Action and yet had failed to do so. Specifically, the Examiner has modified his rejection regarding the un-amended claim limitation “comparing at least one data package of the first data object with at least one data package of the copy of the first data object sent by the second system using a consistency check operation stored within the first data object, the second data object, or the copy of the first data object” (“subject matter at issue”), as recited in claim 1 or similarly provided in claims 13, 25, and 37.

In the previous Office Action dated December 21, 2006, the Examiner indicated that claims 1, 5, 9, 10, 13, 17, 21, 22, 25, 29, 33, 34, and 37 were obvious over Erickson alone. Because believing that the Examiner’s rejection was insufficient at least to subject matter at issue of claims 1, 13, 25, and 37, Applicants traversed the Examiner’s rejection and argued that the subject matter at issue was patentable over Erickson because Erickson taught away from the subject matter at issue, which the Examiner alleged was an obvious variation. Apparently, the Examiner agreed with the Applicants’ position because the Examiner provided Erickson in view of Archibald as a new ground for rejecting the subject matter at issue of claims 1, 13, 25, and 37.

Applicants submit that the Examiner previously had the opportunity to reject the subject matter at issue of claims 1, 13, 25, and 37 using Erickson in view of Archibald, but did not. Therefore, Applicants respectfully submit that the Final Office Action is premature because the Examiner introduced a new ground for rejection that was not necessitated by Applicants’ amending the independent claims. As noted in the previous Response to Office Action dated March 19, 2007 (“Response”), the amendment to the

claims were necessitated only by the Examiner's objections, § 112 rejections, and § 101 rejections and were not for the purposes of overcoming the prior art. Response at page 12. Applicants respectfully submit that the remarks within the Response are consistent with the amendments. Therefore, Applicants respectfully request that the finality of the Office Action be removed.

### **CONCLUSION**

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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